

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested.

This amendment is in response to the Office Action dated October 3, 2003. By the present amendment, independent claim 1 has been amended to clarify the invention and new claims 17 and 18 have been added to define further features of the elected embodiment. The remaining claims 3-5, 7, 9, 10, 12, 13, 15 and 16, directed to non-elected species, have been cancelled, without prejudice to the Applicants' right to file a Divisional application directed to these claims.

In addition, by the present amendment, Figs. 15-18 have been labeled as prior art in response to the requirement to do so in the Office Action.

Reconsideration and allowance of amended independent claim 1 together with claims 2, 6, 8, 11 and 14 over the cited reference to Kanamaru (USP 6531327) is respectfully requested. By the present amendment, independent claim 1 has been amended to define that the beams are double support beams, such as shown in the embodiment of Figs. 1 and 2. As such, all of the independent claims 1, 2, 6 and 11 are now specifically directed to double support beams such as shown in the embodiments of Figs. 1 and 2. In other words, as shown in Figs. 1 and 2(a), the beams 11 are supported at both ends, rather than being cantilevered (as shown in the other embodiments such as Figs. 3-6).

In the Office Action it is stated, for example on page 3, that Fig. 2 of the Kanamaru reference teaches a double supported beam. Applicants respectfully submit that a careful review of Kanamaru shows that this is not, in fact, the case. To the contrary, Fig. 2 of Kanamaru shows a cantilever beam structure rather than a

double support beam structure. This is clear, for example, from the fact that Figs. 1-3 of Kanamaru are all directed to the same embodiment which uses cantilevered beams.

Regarding this, reference is first made to column 3, lines 42-50 of Kanamaru which describes Fig. 1 as a side view of a semiconductor testing equipment according to "an embodiment of the present invention", Fig. 2 as "a perspective view showing the semiconductor testing equipment according to the embodiment of the present invention," and Fig. 3 as "a sectional view of a probe and an electrode pad according to the embodiment of the present invention." In column 4, line 27 et seq., it is defined that Fig. 1 shows the testing equipment connected "so that an easily transformable cantilever is formed on a probe forming substrate 4 and a probe 6 is formed at the tip of the cantilever or near it." On column 7, line 20 et seq., it is stated that this probe forming substrate 4 (of Fig. 1) is shown in a detailed structure in Figs. 2-7. Specifically, column 7, line 23 states "Fig. 2 shows an outer appearance of the probe forming substrate." Subsequently, column 7, line 50 states "Fig. 3 is a sectional view of III-III broken line 10 of Fig. 2." Thus, it is quite clear that Fig. 2 of Kanamaru is simply a more detailed illustration of the probe forming substrate 4 of Fig. 1, while Fig. 3 is a more detailed sectional view of a portion of Fig. 2. More specifically, since both Figs. 1 and 3 both clearly relate to a cantilever probe structure, it is quite clear that the structure shown in Fig. 2 is also a cantilever probe arrangement rather than a double supported probe arrangement.

The fact that Fig. 2 shows a cantilever arrangement is even more specifically defined in column 7, line 24 et seq. describing Fig. 2 as follows:

"The probe forming substrate 4 of the embodiment is made of a silicon material and a cantilever 21 and a probe 6 on one side of the tip portion of the cantilever 21 are formed using the micro-machining technique."

Thus, the element 21 shown in Fig. 2 is clearly a cantilever. Therefore, it is respectfully urged that Kanamaru does not teach a double support beam structure, as defined by all of the pending independent claims, and reconsideration and removal of the rejection of claims 1, 2, 6, 8, 11 and 14 over Kanamaru is earnestly solicited.

With regard to the patentability of the double supported beam arrangement compared to a cantilever arrangement, Applicants respectfully note that the Election Requirement in the present application, dated April 24, 2003, actually provides such an indication of patentability of the double support beam. Specifically the Election Requirement listed Fig. 1, directed to a double support beam arrangement, as a separate species from the cantilever arrangements of Figs. 3 and 5. Since it is required for species to be separately patentable from one another (that is, species must be directed to independent or distinct inventions), the Election Requirement itself serves as evidence of separate patentability of the double support beam arrangement of Fig. 1 from cantilever arrangements. Reference is made to MPEP 806.04(h) headed "Species Must Be Patentably Distinct From Each Other" which notes that when an Applicant files a Divisional application directed to a species non-elected in the parent case "there should be no determination of whether or not the species claimed in the Divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restriction was made." Therefore, since the present claims are all directed to the

species utilizing a double support beam, and since the prior art is clearly directed to a cantilever structure (noting that Figs. 3 and 5 of the present application, which are non-elected species, are also directed to cantilever arrangements), it is respectfully submitted that the double support beam arrangement of the pending claims is clearly patentably distinct over Kanamaru, and reconsideration and allowance of these claims 1, 2, 6, 8, 11 and 14 is earnestly solicited.

Reconsideration and allowance of newly presented dependent claims 17 and 18 is also respectfully requested. These claims more specifically define the arrangement of the claimed first lines and the through-holes as well as the faces of beam where the various elements are located. It is respectfully submitted that this serves to further distinguish the invention over the cited prior art when considered in terms of the overall combination of features defined by these dependent claims. Therefore, reconsideration and allowance of newly presented claims 17 and 18 is also respectfully requested.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of

Application No.: 09/925,375

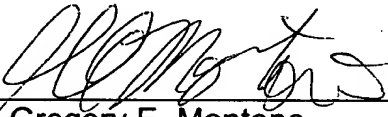
Docket No.: 501.40205X00

this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Docket No. 501.40205X00), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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